



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,938	04/10/2001	Tomoko Terakado	205602US6DIV	8040
22850	7590	04/21/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SAJOUS, WESNER	
			ART UNIT 2676	PAPER NUMBER 15
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,938

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

Art Unit

2676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,20-27,31,33-48,52-61,65-76 and 81-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,20-27,31, 33-48,52-61,65-76 and 81-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Remarks

This communication is responsive to the amendments and response filed on February 18, 2004. Claims 1-2, 4-13, 20-27, 31, 47-48, 52-61, 66-76, and 81-88 are pending in the application.

Response to Arguments

1. The Applicants, at page 19, paragraph 3 of the response argue that Goldstein's favorite channel information is not received from a device that a control device can control and/or the favorite channel is not information received from an electronic apparatus that the controller is controlling.

The Examiner, in response, respectfully disagrees, because Goldstein provides a remote control device that communicates via bi-directional link with a television receiver that receives programming information from a head end cable or a remote data source, wherein the cable system and head end downloads information to the remote control device (see col. 3, lines 17-44). That is, information provided ^{to} ~~by~~ the remote control device is received from the cable converter or head end (which is an electronic apparatus). Further, at col. 26, lines 15-40, suggests that the remote control device can be used to store a user's favorite channel selections and command the television receiver to tune and display subsequent broadcasts. The remote control device has a screen to display the various services for which the user has subscribed (see col. 3, lines 45-51). In view of the above, it is clear that the control device is well capable of

Art Unit: 2676

controlling and receiving information from an electronic device. Therefore, Applicants argument is not persuasive.

At page 20, paragraph 1 of the response, the Applicants argue that the Niimi reference is not applicable (i.e., non-analogous) to the teachings of Goldstein, in that Niimi stores a telephone directory database and Goldstein uses a remote control device for a device such as a cable converter or television receiver.

In response to applicant's argument that the applied prior art is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Goldstein is deficient of detachable memory, and Niimi teaches the detachable memory, as claimed. Further, it is noted that, like Niimi, Goldstein is capable of storing telephonic information in a detachable memory (e.g. a remote control device. See Goldstein's col. 4, lines 14-26.) Thus, the references are applicable.

At paragraphs 3-4 of page 20 of the response, the Applicants contend that does not suggest that the operation in which information stored into the memory 20 is information from an electronic apparatus being controlled by a control device, and that Niimi does not disclose any user controlled operation for controlling the data received from the electronic apparatus to be stored into the memory.

The Examiner, in response, respectfully disagrees because in Niimi it is suggested that information unique to a user of an apparatus is stored in a fixed memory

Art Unit: 2676

and a detachable memory medium can be used to store the information unique to the user (see col. 2, lines 30-35). The ID of a detachable memory can manage a user memory in a terminal. The detachable memory can store the contents of the user memory in the terminal, and upon actuating a predetermined key data in the main body (or terminal) or the detachable memory is displayed. See Niimi's col. 3, lines 46-51.

Thus, upon evaluating the above disclosure, it is apparent that the detachable memory and the user memory from the terminal are linked together, wherein the user memory or terminal is construed as the electronic apparatus, and upon a user command, an operation to store information from the user memory to the detachable memory is permissible, wherein the key input from the user characterizes the control device. Thus, Niimi meets and remedies the deficiencies of Goldstein. Consequently, the rejections are maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2676

3. Claims 1-2, 4-13, 20-23, 25-26, 31, 47, 52, 54-61, 67, 69, 70-74, 75-77, 80-81, and 83-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US Pat. 5,410,326) in view of Niimi et al, US Pat. No. 5996028.

Considering claim 1, Goldstein, at figs. 1-1A, discloses a control device (5) which controls, by transmitting a control signal (*see col. 7, lines 53-55*), an electric apparatus (8, *fig. 1*) that receives information transmitted via a transmission medium (e.g., *IR 29, see fig. 1A*) comprising a transmitting unit (29) for transmitting the control signal to the electric apparatus; a receiver (27) for receiving additional information (e.g., *favorite channels, see col. 6, lines 52-55 or advertising, see abstract*) that has been extracted from the received information and transmitted by the electric apparatus (e.g., the cable TV set); an output means (29) for outputting the additional information received by the receiver to a display device (10); a memory (e.g., *item 488 or 490 of fig. 20, see col. 26, lines 36-39*) for storing at least a portion of said additional information (e.g., *information favored by the user, see col. Col. 6, lines 52-55*).

It is noted that Darbee fails to teach a detachable IC card memory, and erasing unit for deleting the additional information stored in the memory based on a user controlled input.

However, Niimi teaches a detachable IC card memory (*see fig. 3, item 20, col. 2, lines 30-35, col. 2, lines 45-54, and col. 3, lines 46-51*), and erasing unit (*fig. 3, item 8*) for deleting additional information stored in the memory based on a user-controlled input (*see col. 4, lines 42-63, and col. 8, lines 15-64, wherein the additional information corresponds to the data in a subsequent mode that the user operating the system of fig. 3 desires to delete using delete key 8i, as implied in col. 4, lines 42-64*).

Art Unit: 2676

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (10) of Darbee to include the detachable memory and deleting unit as taught by Niimi; in order to allow the user to check the contents of registered data in the memory without requiring a cumbersome operation. See Niimi's col. 1, lines 54-55.

Re claim 2, Goldstein {inherently} discloses additional information is an EPG that is included in the information received by the electric apparatus. See col. 4, lines 28-30, wherein the date and time and channel associated with a future broadcast correspond with EPG information.

Re claim 4, the claimed "selecting unit for selecting ... information received by the receiver, wherein said memory is configured to store the information selected by the selecting unit" is met by the functions performed by item 142 of fig. 14 or figs 2A-D, and col. 10, lines 11-25 of Goldstein.

As per claim 5, (a) the claimed "second storing unit for storing the additional information..." is met by Goldstein's fig. 14, items 143-144.

In claim 6, the claimed "notifying unit for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by the depiction at col. 10, lines 5-40 in Goldstein.

The invention of claim 7 substantially recites the underlying elements of claim 1. As the various elements of claim 1 have been shown to render obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 7 are rejected for the same rationale set forth for claim 1.

Art Unit: 2676

The invention of claim 8 substantially recites the underlying elements as performed by method claim 7. As the various elements of claim 7 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 8 are rejected by the same rationale set forth for claim 7, for in the Goldstein's disclosure, a computer program or software incorporated in devices 28 and 36 is implemented for performing the invention.

The invention of claim 9 recites features substantially the same as claim 8; it is, therefore similarly rejected.

Regarding claim 10, Goldstein discloses an electric apparatus (*e.g., a consumer electronic device or a TV set, see abstract*) which receives information that is transmitted via a transmission medium (*e.g., an antenna or a satellite*) and performs an operation in accordance with a control signal that is transmitted from a control device (10). It is noted that the television set in Goldstein is provided with a bi-directional communication capability with the remote control (see abstract and col. 4, lines 11-30. Thus, all the elements recited in claim 10, including the first receiving unit (27) for receiving the control signal transmitted from a control device (5); a controller (*e.g., a well known microcontroller or CPU*) for performing a control in accordance with the control signal (*e.g., and infrared signal from the remote controller*) received by the first receiving (*e.g., an IR receiver integral in the television set 9*); a second receiving unit (*e.g., a well known television tuner or*) for receiving the information transmitted via the transmission medium; an extracting unit (*e.g., a well known microcontroller or CPU*) for extracting additional information from the information received by the second receiving means; a transmitting unit (*e.g., a well know RF transmitter integral with the TV set*) for transmitting the additional extracted by the extracting means to the control device;

Art Unit: 2676

wherein the control device (5) is configured to store (via items 140-141 of fig. 14) said extracting additional information (e.g., advertisement or program guide information, see col. 4, lines 11-30), although they are not shown in detail by Goldstein, they are noted to be well known components included in a conventional television set (9). These components could facilitate the applied set-top box or cable box (7) in Goldstein to communicate information to and from the remote controller 5. See cols. 7-8 in Goldstein.

It is noted that Goldstein fails to teach a detachable IC card memory, and erasing unit for deleting the information stored in the memory based on a user controlled input.

However, Niimi teaches a detachable IC card memory (see fig. 3, item 20, and col. 2, lines 30-35, col. 2, lines 45-54, and col. 3, lines 46-51), and erasing unit (fig. 3, item 8) for deleting the information stored in the memory based on a user-controlled input (see col. 4, lines 42-63, and col. 8, lines 15-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (5) of Goldstein to include the detachable memory and deleting unit as taught by Niimi; in order to allow the user to check the contents of registered data in the memory without requiring a cumbersome operation. See Niimi's col. 1, lines 54-55.

The invention of claim 11 recites features equivalent to and performing the same functions as apparatus claim 10 and is similarly rejected.

The invention of claim 12 substantially recites the underlying elements as performed by method claim 11. As the various elements of claim 11 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily

Art Unit: 2676

apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 12 are rejected under the same rationale set forth for claim 11, for in the Goldstein, a computer program or software incorporated in items 89-91 of fig. 10 are implemented for performing the invention.

The invention of claim 13, including the limitations of: storing the computer program (e.g., via items 90-91) transmitted from the transmission medium (88); and controlling the electric apparatus (9 by using the computer program (incorporate in items 89-91), substantially recites the underlying elements as performed by method claim 12. As the various elements of claim 12 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 12 are rejected under the same rationale set forth for claim 12, for in the Goldstein's disclosure, a computer program or software could be incorporated in devices 89-91 and/or in the well known microcontroller and ROM integral in the television set for performing the invention.

In claim 20, the claimed "control device instructs the electric apparatus to transmit the additional information" is by the function of item 89 of fig. 10 in Goldstein.

In claim 21, the claimed "notifying means for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by the depiction at col. 10, lines 5-40 of by means of display 9 or 10 in Goldstein.

In claim 22, the claimed "electric apparatus is a personal computer" is obviously met by the depiction at col. 8, lines 42-44. The Applicant should duly note that since the

Art Unit: 2676

system can transmit information via a modem to a data base connected to a local area network, a computer must be include as part of the local area network.

Re claim 23, the claimed "electric apparatus is a television receiver" is met by fig. 1, items 8-9 in Goldstein.

As per claims 25-26, the claimed "output means outputs that part of the additional information which relates to a channel of current reception of the electric apparatus and which relates to information that will be received by the electric apparatus from a present time onward" would have obvious the system of Goldstein, since it enables the user to view program information, identifying PPV information (see figs. 2-8) select information pertaining to specific genres or categories (see fig. 20) and to retrieve the selected category transmitted from the television set. The information when requested, are outputted in display 10 of the remote control. See col. 3, line 1 through col. 5, line 42.

Re claim 31, Darbee discloses the equivalence for the electric apparatus is a personal computer that accesses a server based on information transmitted from the remote control. See col. 8, lines 42-44. The applicant should duly note that since the system can transmit information via a modem to a database connected to a local area network based on instruction from the remote controller 10, it is apparent that the downloaded information can be accessed via a server.

Claim 47 recites features equivalent to and performing the same function as claim 7, it is, therefore, similarly rejected.

Claim 48 is rejected for the same reason as claim 2.

As per claim 52, the claimed "second storing unit for storing the additional information..." is met by Goldstein's fig. 14, items 143-144.

The limitation of claim 53 is met by the functions depicted at fig. 13 of Goldstein.

Art Unit: 2676

Claims 54, 69, and 83 recite features similar to claim 31; they are, therefore, rejected under the same rationale.

In claim 55, the claimed "notifying unit for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by the depiction at col. 10, lines 5-40 in Goldstein.

In claim 56, Goldstein discloses a control device (5) that instructs the electric apparatus (via MPU 89) to transmit the additional information (e.g., advertisement, see abstract).

Re claims 57-59, the claimed "notifying means for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" and the claimed "output means outputs that part of the additional information which relates to a channel of current reception of the electric apparatus" are equivalently met by the function of display 10 of figs. 2-9 in Goldstein.

The invention of claim 60 recites features equivalent to and performing the same functions as claim 47, and is, therefore, subject to rejections for the same reasons and rationale set forth for claim 47.

Claim 61 is rejected for reasons similar to claim 48.

Claims 67, 70-74 recite features similar to and performing the same functions as in claims 52, 55-59 respectively, and they are similarly rejected.

The invention of claim 75 substantially recites the underlying elements as performed by claim 1. As the various elements of claim 1 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 75 are rejected for the same rationale set forth for claim 1.

Art Unit: 2676

Claims 76-77 are rejected for the same reasons as claims 2 and 3 respectively.

In claim 80, the claimed additional information ... advertisement information is stored in a prescribed area at said storing step" would have been obvious over the functionality of the remote controller 5 of Goldstein, for device 5 includes memory 90-91 coupled to controller 89, that upon receiving an instruction from the user may used to store such an additional information as desired by the user.

Claims 81, 84-88, respectively, are rejected for the same reasons as claims 5, 6, and 20-21, and 25-26, respectively.

4. Claims 24, 27, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Niimi and further in view of Hirose.

Considering claims 24, and 27, Darbee, and Niimi render obvious most claimed features of the invention but they fail to suggest that the second electronic apparatus is a recording apparatus performing recording reservation or a computer accesses a server based on the information transmitted from the control device.

Nonetheless, Hirose at fig. 1 illustrates a recording medium 7 as one of a plurality of electronic devices receiving information transmitted from a broadcasting station. Such recording medium is shown interfacing with a receiver. Such receiver is noted to be capable of receiving cable television broadcasting which could be used with a remote controller for transmitting signal to the receiver. Hirose also shows that a personal computer may be used to receive the information via a local area network. It is to be appreciated that computer, by means of the LAN, is able to access a server as is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings suggested by Darbee

Art Unit: 2676

and Takahashi and to incorporate their features with Hirose, in order to enhance the flexibility of the system.

Claim 53 recites features similar to claims 24 and 27 it is, therefore, similarly rejected.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Or:

(703) 308-5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Art Unit: 2676

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesner Sajous whose telephone number is (703) 308-5857. The examiner can also be reached on Mondays thru Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached at (703) 308-6829. The fax phone number for this group is (703) 308-6606.

Wesner Sajous -WS-


4/8/2004



**MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**